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09/680,069	10/05/2000	Daniel R. Pearson	10006131-1	8727

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EXAMINER

POKRZYWA, JOSEPH R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

JAN 27 2006

Technology Center 2600

Application Number: 09/680,069
Filing Date: October 05, 2000
Appellant(s): PEARSON ET AL.

Steven P. Fallon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 14, 2005 appealing from the Office action mailed January 19, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. However, the applicant lists three issues to be reviewed on appeal on pages 3 and 4, with the third issue being related to a 35 U.S.C. 103 rejection of claim 6 and whether the rejection of claims 7-9 should be reversed. The final rejection dated 1/19/05 did not include a rejection under 35 U.S.C 103, as each of claims 1-13 was rejected under 35 U.S.C. 102(b) as being anticipated by Lo et al. (U.S. Patent Number 5,911,044). Further, no arguments appear with respect to this issue. Thus, this issue should be removed.

Further, an additional new ground of rejection appears below.

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. *Claims 1 and 8* are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 1 and 8, while defining a “program”, does not define a “computer-readable medium” and is thus non-statutory for that reasons. A “program” can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claims to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,911,044	LO et al.	6-1999
6,782,426	KUROSHIMA et al.	8-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as noted above.

Claims 1-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Lo et al. (U.S. Patent Number 5,911,044).

For completeness, the rejection, as set forth in the Final Office action, dated 1/19/05, are duplicated below.

Regarding *claim 1*, Lo discloses a program for interfacing a client computer (client computer 102) to one or more scan peripheral devices (scanner server 130), the program comprising functions for querying a scan peripheral for a capability descriptor (scanner parameters or settings, column 12, lines 7 through 50, and column 15, line 34 through column 16, line 64, seen in step 468 in Fig. 8B), determining whether an appropriate capability descriptor is obtained in response to the step of querying (step 470 in Fig. 8B), storing a capability descriptor associated with a scan peripheral for which an appropriate information capability descriptor has been received as determined in the step of determining (step 472 in Fig.

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8C, column 7, lines 16 through 47, column 10, lines 33 through 67, and column 15, line 34 through column 16, line 2), configuring a scan driver (virtual twain device driver 106 or twain driver 136) for a scan job for a scan peripheral when a scan job is requested by a client by linking a set of pre-stored driving modules (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2), a set of pre-stored driving modules being selected according to user set parameters in the scan job and capabilities indicated in a stored information capability descriptor concerning a scan peripheral to which the scan job is directed (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2).

Regarding **claim 2**, Lo discloses the program discussed above in claim 1, and further teaches of a step of de-linking pre-stored driving modules upon completion of a scan job (column 12, lines 38 through 50, and column 17, lines 7 through 18).

Regarding **claim 3**, Lo discloses the program discussed above in claim 1, and further teaches that the step of configuring includes extracting information from a stored capability descriptor to alter a user interface dependent upon a peripheral's capabilities (column 15, line 41 through column 16, line 3).

Regarding **claim 4**, Lo discloses the program discussed above in claim 1, and further teaches that a capability descriptor stored in the step of storing comprises a string including fields indicating dots per inch capabilities (column 15, lines 41 through 55), paper size capabilities (see Fig. 10, "image size"), color/grayscale options (column 15, lines 41 through 55), image formats supported (column 15, lines 41 through 55, and column 22, lines 4 through 16), and whether or not a preview scan is supported (column 15, lines 41 through 55, whereby if no

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slidable graphic control button mark appear, then a lower resolution scan could not be adjusted for a preview image).

Regarding **claim 5**, Lo discloses the program discussed above in claim 1, and further teaches that the program is stored in a server which provides an interface to a network and at least one scan peripheral (column 13, lines 35 through 65).

Regarding **claim 6**, Lo discloses the program discussed above in claim 1, and further teaches that the program is stored in a computer connected to at least one scan peripheral (column 13, lines 35 through 65).

Regarding **claim 7**, Lo discloses the program discussed above in claim 1, and further teaches of functions for obtaining a model of scan peripheral for a peripheral when the function for determining determines that an appropriate capability descriptor was not received in response to a query conducted by the function for querying (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2), and associating a pre-stored capability descriptor with a scan peripheral whose model was determined by the step of obtaining (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2).

Regarding **claim 8**, Lo discloses a scan peripheral server (scanner server 130) having a network connection interface and one or more ports (column 9, lines 1 through 24) for connection to at least one scan peripheral (client computer 102), the server including memory for storing capability descriptors defining capabilities of scan peripherals (column 15, line 56 through column 16, line 2), memory for storing a set of driver modules (column 8, lines 21 through column 9, line 24), and a program for controlling execution of scan jobs requested from the network connection of a scan peripheral connected to one of the one or more ports (column 7,

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lines 48 through column 8, line column 9, line 24), the program comprising functions for obtaining a capability descriptor from one or more scan peripherals connected to any of the one or more ports (column 12, lines 20 through 50, and column 15, lines 10 through 65), storing a received capability descriptor in the memory for storing capability descriptors (column 15, lines 56 through 65), accepting a scan job request from the network connection for one or more scan peripherals attached to the one or more ports (column 16, lines 10 through 64), extracting capability information from a stored capability descriptor in response to a scan job (column 16, lines 54 through 64), sending information to the network connection to modify a user interface (column 15, lines 10 through 40), accepting parameters for a scan job from the network connection (column 15, lines 41 through 65), linking driver modules from the set of driver modules according to capability information extracted by the function for extracting and parameters accepted by the function for accepting (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2), and controlling a scan job according to the driver modules linked in the function for linking (column 16, lines 10 through 64).

Regarding *claim 9*, Lo discloses the server discussed above in claim 8, and further teaches that the capability descriptor comprises a data string of capability data (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2).

Regarding *claim 10*, Lo discloses the server discussed above in claim 8, and further teaches that the program for controlling execution of scan jobs comprises obtaining model information from any one or more scan peripherals connected to any of the one or more ports when the any one or more scan peripherals does not provide a capability descriptor (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2), and associating a

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capability descriptor pre-stored in the memory for storing capability descriptors with the any one or more scan peripherals which does not provide a capability descriptor according to model information obtained in the step of obtaining (column 12, lines 20 through 62, and column 15, line 41 through column 16, line 2).

Regarding *claim 11*, Lo discloses the server discussed above in claim 8, and further teaches that a data string is formatted as a data string including a scan language, an image format, a resolution and a preview scan capability (see Fig. 10, column 15, lines 41 through 55, and column 22, lines 4 through 49).

Regarding *claim 12*, Lo discloses a peripheral (scanner server 130) including a scanning capability (column 7, lines 48 through 60), the peripheral comprising a scan system for scanning documents (scanner 144) and producing electronic data therefrom (column 5, lines 47 through 65), an interface for connecting to a client machine or server (server protocol encoder/decoder 132, connected to the client computer 102, column 7, lines 16 through 47), memory for storing data (column 8, lines 21 through 41), a scan capability descriptor stored in the memory (column 8, line 21 through column 9, line 24), and a controller for communicating with the client machine or server (client computer 102) through the interface to perform a scan job (column 12, lines 20 through 50, and column 15, line 41 through column 16, line 64), the controller sending the capability descriptor to the client machine or server through the interface in response to a query requesting a capability descriptor (column 12, lines 20 through 50, and column 15, line 66 through column 16, line 64).

Regarding *claim 13*, Lo discloses a method for controlling a scan job directed to a peripheral (scanner server 130) including a scanning function (column 7, lines 48 through 60),

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the method comprising steps of obtaining a capability descriptor from the peripheral including the scanning function (column 12, lines 20 through 50, and column 15, line 41 through column 16, line 2), then to implement a scan job (column 16, lines 3 through 64), configuring a scan driver from a set of scan drive modules based upon capabilities indicated by the capability descriptor and parameters included in the scan job (column 12, lines 20 through 50, and column 15, line 66 through column 16, line 64).

(10) Response to Argument

In response to applicant's argument's under Heading I, regarding the rejection of independent claims 1, 8, and 13, as being anticipated by Lo, whereby applicant argues on pages 4-6 that the examiner has ignored the common meaning given to scan drivers and scan parameters known within the art, as the examiner uses an unreasonable determination that Lo's scan parameters are the same as pre-stored driving modules. First the examiner notes that the claim 1 currently states "configuring a scan driver for a scan job for a scan peripheral when a scan job is requested by a client by linking a set of pre-stored driving modules, a set of pre-stored driving modules being selected according to user set parameters in the scan job and capabilities indicated in a stored information capability descriptor concerning a scan peripheral to which the scan job is directed". Particularly, with respect to independent claim 1, Lo teaches of configuring a scan driver, which is interpreted as the virtual TWAIN device driver 106 or TWAIN driver 136, as seen in Fig. 3. Continuing the TWAIN drivers 106 or 136 are configured by linking a set of pre-stored driving modules, being interpreted as the linking of each of the parameters so as to configure the virtual device driver, as seen in column 13, lines 45-51,

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wherein Lo states “the software is installed as a TWAIN compatible device driver. As the device driver allows functions such as setting the scanner parameters to be performed as if the scanner were directly connected to the client computer, the device driver is referred to as a virtual TWAIN device driver.”

Further, as additionally read in column 13, line 51-column 14, line 7, a number of different software are linked in order to perform the scan-to-application operation. This also can be interpreted as linking a set of pre-stored driving modules so as to configure the TWAIN driver. This is further shown by the reference of Kuroshima *et al.* (U.S. Patent Number 6,782,426), which was not relied on in the rejection, but which shows that standard operation of a TWAIN driver, as was known in the art at the time the invention was made. As read in column 15, lines 30-60, and in column 17, lines 3-9 of Kuroshima, the TWAIN driver 36 is configured to operate by linking a number of pre-stored modules, based on a parameters of the operation.

Continuing, applicant argues under sub-headings a-d on pages 6-10 that Lo does not teach the ordinary meaning of for “pre-stored driving modules” as stated in claim 1, a stored “set of driver modules” as stated in claim 8, or a “set of scan drive modules” as stated in claim 13, and that the ordinary meaning is ignored in the rejection. As discussed above, Lo can be interpreted as teaching of linking of pre-stored modules, as the various software is linked in order to perform the scan-to application, as read in column 13, line 51-column 14, line 7. Further, as was known in the art at the time the invention was made, a virtual scan driver is configured by linking a set of inherent modules. This is also shown in the above referenced reference of Kuroshima. Thus, the reference of Lo can be reasonable interpreted as teaching of configuring a scan driver for a scan job for a scan peripheral when a scan job is requested by a client by linking

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a set of pre-stored driving modules, with a set of pre-stored driving modules being selected according to user set parameters in the scan job and capabilities indicated in a stored information capability descriptor concerning a scan peripheral to which the scan job is directed.

Continuing, applicant's arguments on pages 8-10, which state that Lo requires a software device driver 42 which is software which controls the image acquisition device and is written by the device developer to comply with TWAIN specifications. The examiner notes that the indicated device driver 42 is seen in Fig. 1, which is noted as prior art in the reference, which is an explanation of how *conventional* TWAIN compatible application programs operate, as read in column 4, line 64-column 5, line 46. The teachings of Lo are motivated to overcome the disadvantages with conventional systems, as read in column 1, lines 59-67, as Lo states, "there is no direct control of the scanner by the client computer nor can an application directly input the image file from a scanner." Further, as read in column 2, lines 28-34, Lo's invention of the "virtual TWAIN driver" overcomes this problem with conventional drivers. The virtual TWAIN driver is seen in Frig. 3 as element 106, being different than what applicant argues as the driver 42.

In response to applicant's argument's under Heading II, regarding the rejection of independent claim 12, as being anticipated by Lo, whereby applicant argues on pages 10 and 11 that the rejection fails to recognize the clear meaning given to the term "capability descriptor" in the claims and the specification. The examiner notes that claim 12 currently requires "a scan capability descriptor stored in said memory; and a controller for communicating with said client machine or server through said interface to perform a scan job, said controller sending said capability descriptor to said client machine or server through h said interface in response to a

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query requesting a capability descriptor.” There is no meaning to the term “capability descriptor” in the claim. The examiner reasonably interprets the term as being the “scanner parameters” taught by Lo. As read in column 7, lines 48-51, Lo teaches of scan task software 134 within the scanner server 130 that “controls the scanning operations for both the scan-to-application operation and the scan-to-file operation.” Thus, as seen in Fig. 3, the scanner server 130 comprises a “system” for scanning documents and producing electronic data therefrom, being interpreted as the scan task software 134, along with the combination of the TWAIN driver 136, the SCSI interface 138, and the scanner 144. With this, Lo can be seen as teaching of the peripheral (scanner server 130) storing in its memory a scan capability descriptor, as read in column 8, line 21 through column 9, line 24, and communicating the capability descriptor in response to a query requesting the same, as read in column 12, lines 20 through 50.

Therefore, the examiner believes that the rejection of claims 1-13, as cited in the Office action dated 1/19/05, under 35 U.S.C. 102(b) as being anticipated by Lo et al. (U.S. Patent Number 5,911,044) should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one

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of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,



Joseph R. Pokrzywa

Primary Examiner

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:



Edward Coles

EDWARD COLES
SUPERVISOR, TECHNICAL EXAMINER

David Moore

